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James S. Keddie, Ph.D.  
Bozicevic, Field & Francis, LLP  
1900 University Avenue, Suite 200  
East Palo Alto, CA 94303

In re Application of

GLENN, et al.

Application No.: 10/528,377

PCT No.: PCT/US04/27070

Int. Filing Date: 18 August 2004

Priority Date: 22 August 2003

Atty. Docket No.: STAN-316

For: METHODS AND COMPOSITIONS FOR  
IDENTIFYING ANTI-HCV AGENTS

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicants' "Request for Corrected Notice of Acceptance of Application Under 35 U.S.C. 371" filed 12 June 2006 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 18 August 2004, applicant filed international application PCT/US04/27070 which claimed a priority date of 22 August 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 22 February 2006.

On 16 March 2005, applicant filed a Transmittal Letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *among others*, the requisite basic national fee; a copy of the international application; an application data sheet and a biochemical sequence diskette. Applicant did not mark Box 3 on the transmittal letter (PTO-1390) which states "[t]his is an express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Article 22 and 39(1)."

On 05 December 2005, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors was required, as well as, payment of the \$65.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date. Applicant was afforded two months to file a proper response.

On 04 January 2006, applicant responded with an executed declaration of the inventors.

On 02 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903) which set forth the date of receipt 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements as 04 January 2006 and a

35 U.S.C. 371 completion date of 22 February 2006.

On 12 June 2006, applicant filed "Request for Corrected Notice of Acceptance of Application Under 35 U.S.C. 371."


### DISCUSSION

Applicants request that the date of completion of requirements on the Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495 should be corrected to 04 January 2006. The Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903) indicates the date of receipt of the 37 U.S.C. 371 (c)(1), (c)(2), and (c)(4) requirements and it also indicates the date of completion of all 35 U.S.C. 371 requirements. MPEP §1893.03(b) states that the date of completion of all 35 U.S.C. 371 requirements will be later than the date of receipt of the 37 U.S.C. 371 (c)(1), (c)(2), and (c)(4) when a request for early processing has not been requested prior to 30 months from the priority date. Here, applicants submitted the last of the requirements set forth in 35 U.S.C. 371(c)(1), (c)(2), and (c)(4), the executed declaration, on 04 January 2006. However, applicant did not check Box 3 on the transmittal letter (PTO-1390) which states "[t]his is an express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Article 22 and 39(1)" and therefore, national stage processing or the date of completion of all 35 U.S.C. 371 requirements could not begin prior to 30 months from the priority date, 22 February 2006. Therefore, the correction of the Notification of Acceptance to indicate a date of 04 January 2006 is not proper since the requirements set forth in 35 U.S.C. 371 were completed on 22 February 2006.

### CONCLUSION

Applicants' request for the issuance of a corrected Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 is **REFUSED**.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: 571-272-3294  
Fax: 571-273-0459